

REMARKS/ARGUMENT

Initially, Applicants would like to thank Examiners Lorengo and Parvini for the courteous and helpful Interview conducted August 8, 2007, which Applicants believe materially advance prosecution in this case.

Claims 1 and 13 have been amended to require the tamped density to be 20 to less than 70 g/l. Also, new claims 27 and 28 have been added, requiring the tamped density to be 20-60 g/l. Support for these new claims and amendments exists throughout the present specification, including the examples and page 3, lines 13-15.

The abstract has also been amended. Applicants request amendment of the existing abstract by replacement abstract attached on a separate sheet to this amendment.

Claims 1-28 are currently pending.

The Office Action rejected claims 1-4 and 13-16 under 35 U.S.C. § 102 as anticipated by CA 2255456 ("Siray"), and claims 5-12 and 17-26 under 35 U.S.C. § 103 as obvious over U.S. patent 5,034,207 ("Kerner") in view of Siray. In view of the following comments, Applicants respectfully request reconsideration and withdrawal of these rejections.

The claimed invention relates to precipitated silica having a low tamped density (20 to less than 70 g/l) and a high DBP number (350-400 g/100 g). The art upon which the Examiner relies neither teaches nor suggests such silica having both of these characteristics, let alone all of the elements required by the claims.

Siray discloses silica having a tamped density of at least 70 g/l. In this regard, Applicants note that Siray's discussion of the wax-coated silica on page 4 clearly includes a typographical

error. That is, given that Siray's abstract, Siray's claim 3 and the entire remainder of Siray's disclosure require the compacted density of wax-coated silica to be at least 70 g/l (that is, to be 70-140 g/l), the disclosure on page 4 clearly should have been 70-140 g/l in accordance with the remainder of Siray's disclosure, not 7-140 g/l, a range for which no other support or disclosure exists.

Furthermore, Applicants note that in the Rule 132 declaration (at par. 2) originally submitted February 2, 2007, and a complete copy of which is submitted concurrently herewith, it is demonstrated that none of Siray's examples disclose precipitated silica having a tamped density of 20 to less than 70 g/l or a DBP number of 350-400 g/100 g, let alone precipitated silica having both of these characteristics. Thus, Siray does not inherently disclose the claimed silica.

In contrast, the amended claims require the tamped density to be less than 70. In fact, new claims 27 and 28 require the tamped density to be 60 or less. Accordingly, no overlap exists with respect to tamped density of the claimed silica and the compacted density of Siray's silica.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102.

Regarding the rejection under § 103, Kerner is cited merely for its use of silicas. Because neither of the cited references teaches or suggests the claimed silica, their combination cannot yield the claimed silica. For this reason alone, Applicants respectfully submit that no *prima facie* case of obviousness exists, and that the § 103 should be withdrawn.

Moreover, nothing in either of the references would have motivated one skilled in the art to modify the silica disclosed therein to arrive at the claimed precipitated silica. More

specifically, nothing in either of the cited references would lead one skilled in the art to the claimed precipitated silica having both low tamped density (20 to less than 70 g/l) and high DBP number (350-400 g/100g). Following the preparation methods set forth in Siray, one skilled in the art would obtain silica having tamped density of 72-85 g/l and a DBP number of 320-333 g/100g, (see, Rule 132 declaration, par. 3), and no teaching or suggestion exists in either of the cited references concerning how to modify the preparation methods to achieve precipitated silica having both low tamped density (20 to less than 70 g/l) and high DBP number (350-400 g/100g). (See, Rule 132 declaration, pars. 3-4). In other words, following Siray would not lead one skilled in the art to the claimed silica, and nothing in Kerner compensates for Siray's deficiencies. For this reason as well, Applicants respectfully submit that no *prima facie* case of obviousness exists, and that the § 103 should be withdrawn.

Finally, even assuming that a *prima facie* case of obviousness exists (which, as explained above, is not the case), sufficient data demonstrating superior and beneficial results associated with the claimed silica are disclosed in the present application to rebut any such hypothetical case of obviousness. More specifically, as demonstrated on page 7 of the present application, the invention silicas possess improved matting efficiency over comparative silicas.

As explained in the attached Rule 132 declaration, examples 1, 3, 4 and 5 correspond to the invention silicas. (See, Rule 132 declaration, par. 5). These examples all have gloss 60° values which are surprisingly lower than the gloss value of Example 2 (DBP number of 333 g/100 g) and the comparative composition containing Acematt HK 450. (See, Rule 132 declaration, par. 5). This difference in matting efficiency between the invention silicas and the comparative silicas was surprising and unexpected given the similarity of the silicas. (See, Rule

132 declaration, par. 6). The difference in matting efficiency between the invention silicas and the comparative silicas demonstrates the surprising and unexpected benefit derived from having properties associated with the invention silicas. (See, Rule 132 declaration, par. 8). What's more, the improved matting efficiency associated with the invention silicas are commercially significant -- clearly, silicas which possess more effective matting properties are more commercially viable than less effective silicas. (See, Rule 132 declaration, par. 9).

In view of the above, Applicants respectfully submit that sufficient data exists demonstrating the unexpected and surprising matting properties of the claimed silicas to rebut any hypothetical *prima facie* case of obviousness which might exist.

For all of the above reasons, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103.

Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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